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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,557	06/18/2001	Martin D. Koenig	4437-2	1087

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/883,557

Applicant(s)

KOENIG ET AL.

Examiner

Alexander Kalinowski

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*NEW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application***

1. This communication is in response to the application filed on December 29, 2000. As of the date of this communication the applicants have not filed an Information Disclosure Statement (IDS) for this application. The examiner acknowledges the amended claims filed on June 15, 2004 and these claims, claims 1-20, have been examined.

### ***Claim Objections***

2. Claims 3 and 9 are objected to because of the following informalities:  
It is not clear from the body of the claim language which party or entity receives payment for the claim from the third party payor. Appropriate correction and/or clarification is required.

For the purposes of examination, the examiner will interpret this claim as meaning that the payment is transferred from the third party payor directly to the manufacturer of the device.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2001/0034618 to Kessler in view of US Patent Application Publication 2003/0014318 to De La Motte.

Kessler is directed towards a healthcare payment and compliance system while De La Motte is directed towards an international trading system and method.

As per claim 1, which is directed towards a method of providing a device, the cost of which is covered by a third party payor, to a health care facility and obtaining payment for the device from the third party payor, Kessler teaches the step of submitting a request for the device from the health care facility (102) to the third party payor (106) for authorization of payment (Section [0090]). The third party payor (106) is an insurance company in one embodiment (Section [0005]) and the third party payor (106), beneficiary (health care facility-(102)) and provider (manufacturer-(104)) are all interconnected through a network (Figure 1A and Section [0102]). The network in Kessler includes an application service provider (120) that contracts with providers to provide medical products (devices) and services (treatments), upon authorization, however this system is not a transaction facilitator (Kessler , Section [0121]).

De La Motte teaches a transaction facilitator which contacts a manufacturing facility to order a device (Sections [0039]-[0040]). Furthermore, De La Motte teaches a step in which the transaction facilitator generates a cost claim (invoice) for the device (Section [0049]). The supplier (manufacturer) delivers the device by hand delivery to the buyer (health care facility) in one embodiment (Section [0043]).

At the time the invention was made, one of ordinary skill in the art would have been motivated to include a transaction facilitator (as taught in De La Motte) in the network of Kessler in order to have provided the beneficiary (health care facility-(102)) in Kessler with a more efficient means of linking to suppliers of products (devices) directly rather than through one or more levels of market intermediaries and in order to have broadened market participating of both buyers and supplies by exposing them to a global network of market participants (Section [0019]). In the combined system of Kessler in view of De La Motte, the examiner takes the position that it is within the scope of the combined system to have relayed the request for the quote (request for the device) from the third party payor (102) to the transaction facilitator since they are all interconnected by the network (Kessler, Figure 1A and Section [0102]).

As per claim 2, in Kessler all the entities are connected via a network and communicate electronically (Kessler, Figure 1A and Section [0102]). In the combined system of Kessler in view of De La Motte, the examiner takes the position that each party would have communicated with each through electronically, which includes communicating through a website.

As per claim 3, in the combined system of Kessler in view of De La Motte, the supplier (manufacturer) receives payment for the invoice (claim) from the third party payor and the third party payor transfers funds to the manufacturer for the payment of the device (Kessler, Section [0121]).

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As per claim 4, in the combined system of Kessler in view of De La Motte, the health care facility (beneficiary-(102)) contacts the transaction facilitator (through a website) to submit the request for the device (De La Motte, Sections [0025] and [0039]).

As per claim 5, in the combined system of Kessler in view of De La Motte, the step of order the device includes generating an electronic message from the website of the transaction to the manufacturer indicating that an order has been placed for the medical device (De La Motte, Sections [0040] and [0049]).

As per claim 6, in the combined system of Kessler in view of De La Motte, the device manufacturer accesses the website of the transaction facilitator to receive the order placed by the third party payor (De La Motte, Section [0050]).

5. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2001/0034618 to Kessler in view of US Patent Application Publication 2003/0014318 to De La Motte.

As per claim 7, which is directed towards a method of providing a prescribed medical device covered by insurance to a healthcare facility and obtaining payment for the medical device from an insurance provider, Kessler teaches the step of submitting a request for the device from the health care facility (102) to the insurance provider (106) for authorization of payment (Section [0090]). The third party payor (106) is an insurance company in one embodiment (Section [0005]) and the third party payor (106), beneficiary (health care facility-(102)) and provider (manufacturer-(104)) are all interconnected through a network (Figure 1A and Section [0102]). The network in Kessler includes an application service provider (120).

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Kessler fails to teach or suggest a transaction facilitator which is part of the network and separate from the insurance provider and the health care facility; however, this feature is well known in the art as evidenced by De La Motte. De La Motte teaches a transaction facilitator which electronically contacts a manufacturing facility to order a device (Sections [0039]-[0040]). Furthermore, De La Motte teaches a step in which the transaction facilitator generates a cost claim (invoice) for the device (Section [0049]). The supplier (manufacturer) delivers the device by hand delivery in one embodiment to the buyer (healthcare facility) (Section [0043]).

At the time the invention was made, one of ordinary skill in the art would have been motivated to include a transaction facilitator (as taught in De La Motte) in the network of Kessler in order to have provided the beneficiary (health care facility-(102)) in Kessler with a more efficient means of linking to suppliers of products (devices) directly rather than through one or more levels of market intermediaries and in order to have broadened market participating of both buyers and supplies by exposing them to a global network of market participants (Section [0019]). In the combined system of Kessler in view of De La Motte, the examiner takes the position that it is within the scope of the combined system to have relayed the request for the quote (request for the device) from the third party payor (102) to the transaction facilitator since they are all interconnected by the network (Kessler, Figure 1A and Section [0102]).

As per claim 8, in Kessler all the entities are connected via a network and communicate electronically (Kessler, Figure 1A and Section [0102]). In the combined system of Kessler in view of De La Motte, the examiner takes the position that each

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party would have communicated with each through electronically, which includes communicating through a website.

As per claim 9, in the combined system of Kessler in view of De La Motte, the supplier (manufacturer) receives payment for the invoice (claim) from the insurance provider and the insurance transfers funds to the supplier (manufacturer) for the payment of the device (Kessler, Section [0121]).

As per claim 10, in the combined system of Kessler in view of De La Motte, the health care facility (beneficiary-(102)) contacts the transaction facilitator (through a website) to submit the request for the device (De La Motte, Sections [0025] and [0039]).

As per claim 11, in the combined system of Kessler in view of De La Motte, the step of order the device includes generating an electronic message from the website of the transaction to the manufacturer indicating that an order has been placed for the medical device (De La Motte, Sections [0040] and [0049]).

As per claim 12, in the combined system of Kessler in view of De La Motte, the device manufacturer accesses the website of the transaction facilitator to receive the order placed by the insurance provider (De La Motte, Section [0050]).

6. Claims 13-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2001/0034618 to Kessler in view of US Patent Application Publication 2003/0014318 to De La Motte.

As per claim 13, which is directed towards a method of providing a device for use with a patient, the cost of which is covered by a third party payor, to a healthcare facility, Kessler teaches the step of electronically submitting a request for a proposed treatment



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and a preferred device from the healthcare facility to the third party payer (Sections [0090] and [0121]). Furthermore, Kessler teaches the step of providing electronic authorization from the third party payor to the healthcare facility for the proposed treatment (Sections [0090] and [0121]).

Kessler fails to teach the step of relaying the request (for a proposed treatment) from the third party payor to a transaction facilitator (upon authorization) and utilizing a transaction facilitator to contact a manufacturer for the device to order the device. Kessler does teach an application service provider (ASP) (120) that contracts with providers to provide medical products (devices) and services (treatments), upon authorization, however this system is not a transaction facilitator (Kessler, Section [0121]).

De La Motte teaches a transaction facilitator which contacts a manufacturing facility to order a device (Sections [0039]-[0040]). Furthermore, De La Motte teaches a step in which the transaction facilitator generates a cost claim (invoice) for the device (Section [0049]). The supplier (manufacturer) delivers the device by hand delivery to the buyer (health care facility) in one embodiment (Section [0043]).

At the time the invention was made, one of ordinary skill in the art would have been motivated to include a transaction facilitator (as taught in De La Motte) in the network of Kessler in order to have provided the beneficiary (health care facility-(102)) in Kessler with a more efficient means of linking to suppliers of products (devices) directly rather than through one or more levels of market intermediaries and in order to have broadened market participating of both buyers and supplies by exposing them to a

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global network of market participants (Section [0019]). In the combined system of Kessler in view of De La Motte, the examiner takes the position that it is within the scope of the combined system to have relayed the request for the quote (request for the device) from the third party payor (102) to the transaction facilitator since they are all interconnected by the network (Kessler, Figure 1A and Section [0102]).

As per claim 14, in Kessler the step of authorizing proposed treatment and the preferred device includes providing patient identification information and insurance coverage information to the third party payor prior to authorization (Section [0090]).

As per claim 15, in Kessler the request for the preferred device is made after the healthcare facility receives authorization for the proposed treatment (Section [0121]).

As per claim 17, in Kessler the third party payor includes an on-line website such that the requests for the proposed treatments and the preferred device are submitted to the third part payor website (Figure 1A and Sections [0090], [0102], [0104] and [0121]).

As per claim 18, in the combined system of Kessler and De La Motte, the transaction facilitator includes an on-line website such that the third party payor electronically contacts the transaction facilitator electronically (De La Motte, Section [0019] and [0025] and Kessler, Figure 1A and Sections [0090], [0102], [0104], and [0121]).

As per claim 19, in Kessler the step of requesting the preferred device includes selecting the preferred device from a list of devices (Figures 5D-5E and Section [0238]).

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As per claim 20, in Kessler the request for the proposed treatment and the preferred device are both made prior to the electronic authorization from the third party (Section [0090]).

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2001/0034618 to Kessler in view of US Patent Application Publication 2003/0014318 to De La Motte, as applied to Claim 13, above, and in further view of US Patent Number 6,055,514 to Wren.

Kessler and De La Motte fail to teach or suggest a step by which authorization of a treatment and device take place only after the healthcare facility has been prompted to respond to pre-determined treatment questions; however, this feature is well known in the art as evidenced by Wren (Col. 29-39). At the time the invention was made, one of ordinary skill in the art would have been motivated to add this question prompting feature to the system of Kessler in view of De La Motte in order to have obtained an authorization means which enabled the third party payor to approve a request for a treatment or device based on more complete information.

### ***Conclusion***

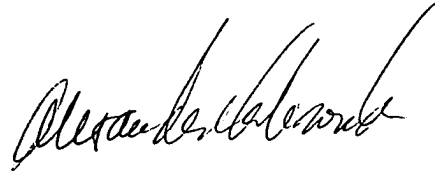
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax

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telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is fluid and cursive, with a large, sweeping initial 'A'.

Alexander Kalinowski

Primary Examiner

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9/30/2004